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10/733,102	12/10/2003	Osama Elkady	50277-2319	9183
43425 7590 06/12/2009 HICKMAN PALERMO TRUONG & BECKER/ORACLE 2055 GATEWAY PLACE SUITE 550 SAN JOSE, CA 95110-1083				
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MCLEAN, NEIL R				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/733,102

Applicant(s)

ELKADY ET AL.

Examiner

Neil R. McLean

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. Claims 1-32 are now pending in this application.

Claims 30-32 are new.

Response to Arguments

2. Applicant's arguments, with respect to the rejection(s) of claim(s) 1-32 are persuasive, therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made over Schwier et al. (US 7,202,972) hereinafter 'Schwier' in view of Warmus et al. (US 5,963,968) hereinafter 'Warmus'.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwier et al. (US 7,202,972) hereinafter 'Schwier' in view of Warmus et al. (US 5,963,968) hereinafter 'Warmus'.

Regarding Claim 1: (previously presented)

Schwier et al. discloses a method comprising:

receiving (In order to merge the system must receive a merge command from the browser or program code), at a merge utility (e.g., Winword Application 10 in Figure 2) executing on a computer system (e.g., Personal Computer 1 in Figure 1), a first merge document (e.g., Static Data 12 created by WinWord Application 10 in Figure 2);

converting a second document (e.g., Excel document) from an original format to the merge format to create a second merge document (e.g., PCL described in Column 1, lines 16-20);

wherein the second document was created by a first document authoring application (e.g., WinWord Program 10 in Figure 2);

wherein the second merge document is in the merge format (e.g., PCL described in Column 1, lines 16-20);

wherein the step of converting is performed by either the merge utility or the first document authoring application (e.g., Column 5, lines 23-43);

using the merge utility executing on the computer system, merging the first merge document (e.g., Variable Data V) and the second merge document (e.g., Static Data S) to generate a composite merge document (e.g., V+S (EMF) 13 in Figure 2); and

after generating the composite merge document delivering said composite merge document to an output device (FIG. 3 shows a selection window that is selected before the printing event from the application ensues into the EMF intermediate datafile (event 13). The input window 20 contains a first selection window 21 in which two print modes can be selected. In the first print mode (standard), print data from the windows application are printed out in a standard way, i.e. the filter procedure (event 14) does not occur. Series letters are then transmitted to the printer device 7 individual document by individual document.);

wherein the output device is a device that is different from the computer system (e.g., printer device 7 of Figure 1 and 2);

wherein the original format is a format that is not supported by the output device (e.g., EMF Format); and

therefore needs to be converted to another format that is supported by the output device in order to be properly interpreted by the output device (e.g., using PCL Converter 18 of Figure 2); and

wherein the merge format is a format that is supported by the output device (e.g., PCL); and

therefore does not need to be converted to another format that is supported by the output device in order to be properly interpreted by the output device (e.g., EMF to PCL converter 58 of Figure 9).

Schwier does not disclose expressly a first document that is in a merge format.

Warmus discloses a first document that is in a merge format (Figure 2; step 42 creates one or more master and variable page files in, for example, a page description language (PDL) such as PostScript.RTM as described in Column 4, lines 55-63).

Warmus & Schwier are combinable because they are from the same field of endeavor of image processing; e.g., both references disclose methods of merging documents. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have at least one document in a merge format.

The suggestion/motivation for doing so to: e.g., If multiple substantially similar copies of a document are desired, ripping the document can be expedited by identifying fixed and variable portions of the document, ripping the fixed portion (the base document) only once. Warmus discloses in the Background of Invention the time consuming process associated with rasterizing documents into a format that can be displayed or printed. Therefore, it would have been obvious to combine Warmus with Schwier to obtain the invention as specified in order to permit high speed printing of quality images with differing versions an/or personalized information within a single production run (Warmus; Column 3, lines 40-45).

Regarding Claim 15: (previously presented)

Claim 1 teaches the method. Claim 15 is obvious in view of Schwier and Warmus because a computer-readable medium containing computer executed instructions is achieved using the method steps of Claim 1.

Regarding Claim 2: (original)

Schwier et al. further discloses the method of claim 1 further comprising: generating the first merge document in said merge format by converting a first original document from an original format to the merge format (See PCL converter 58 in Figure 9).

Regarding Claim 16: (previously presented)

Claim 2 teaches the method. Claim 16 is obvious in view of Schwier and Warmus because a computer-readable medium containing computer executed instructions is achieved using the method steps of Claim 2.

Regarding Claim 3: (original)

Schwieer et al. further discloses the method of claim 1, wherein the merge format is Standard Printing and Imaging Format (SPIF) (Column 3, lines 61-64; 'the conversion of the data stream into a print language such as PCL or postscript').

Regarding Claim 17: (previously presented)

Claim 3 teaches the method. Claim 17 is obvious in view of Schwier and Warmus because a computer-readable medium containing computer executed instructions is achieved using the method steps of Claim 3.

Regarding Claim 4: (original)

Schwieer et al. further discloses the method of claim 3, wherein the merge format is PDL Postscript (Column 3, lines 61-64; 'the conversion of the data stream into a print language such as PCL or **postscript**').

Regarding Claim 18: (previously presented)

Claim 4 teaches the method. Claim 18 is obvious in view of Schwier and Warmus because a computer-readable medium containing computer executed instructions is achieved using the method steps of Claim 4.

Regarding Claim 5: (original)

Schwier et al. further discloses the method of claim 1, wherein the first document is a background template document and the second document is an overlay document (Column 8, lines 64-67; 'The placement type as an **overlay** (complete superimposition) or a **watermark** (macro information only in the background) within the document **can be selected** with the selection field 44').

Regarding Claim 19: (previously presented)

Claim 5 teaches the method. Claim 19 is obvious in view of Schwier and Warmus because a computer-readable medium containing computer executed instructions is achieved using the method steps of Claim 5.

Regarding Claim 6: (previously presented)

Schwier et al. further discloses the method of claim 5, wherein the background template document is originally created by a second document authoring **application** (Column 5, lines 23-30; 'Various application programs in turn run under this operating system, for example the **application** 10 Winword 97.RTM. from the Microsoft Office 97.RTM. package'); and

wherein the second document authoring application is different (Column 5, lines 35-38; 'The variable data areas are intended to be filled with variable data that are stored in a separate datafile (a Word document, data bank, an Excel document, etc.)) from said first document authoring application.

Regarding Claim 20: (previously presented)

Claim 6 teaches the method. Claim 20 is obvious in view of Schwier and Warmus because a computer-readable medium containing computer executed instructions is achieved using the method steps of Claim 6.

Regarding Claim 7: (original)

The method of claim 5, wherein the background template document is created in a second original format (Column 5, lines 35-38; 'The variable data areas are intended to be filled with variable data that are stored in a separate datafile (a Word document, data bank, an Excel document, etc.)) and converted from the second original format to the merge format (See PCL converter 58 in Figure 9).

Regarding Claim 21: (previously presented)

Claim 7 teaches the method. Claim 21 is obvious in view of Schwier and Warmus because a computer-readable medium containing computer executed instructions is achieved using the method steps of Claim 7.

Regarding Claim 8: (previously presented)

Schwier et al. further discloses the method of claim 7, wherein the conversion of the second original document to the merge format occurs at the merge utility (FIG. 3 shows a selection window that is selected before the printing event from the application ensues into the EMF intermediate datafile (event 13). The input window 20 contains a first selection window 21 in which two print modes can be selected. In the first print mode (standard), print data from the windows application are printed out in a standard way, i.e. the filter procedure (event 14) does not occur. Series letters are then transmitted to the printer device 7 individual document by individual document.).

Regarding Claim 22: (previously presented)

Claim 8 teaches the method. Claim 22 is obvious in view of Schwier and Warmus because a computer-readable medium containing computer executed instructions is achieved using the method steps of Claim 8.

Regarding Claim 9: (previously presented)

Schwier et al. further discloses the method of claim 1, wherein the converting of the second document from the original format to the merge format to create the second merge document includes:

generating, based on the original format, a set of conversion instructions (The program code or device which enables the PCL converter 18 in Figure 2) to convert the second document into said second merge document;

passing the set of conversion instructions to a document authoring application (Column 4, lines 15-20); and

the first document authoring application generating the second merge document based on said set of conversion instructions (Column 4, lines 15-20).

Regarding Claim 23: (previously presented)

Claim 9 teaches the method. Claim 23 is obvious in view of Schwier and Warmus because a computer-readable medium containing computer executed instructions is achieved using the method steps of Claim 9.

Regarding Claim 10: (previously presented)

Schwier et al. further discloses the method of claim 1, wherein the method further comprises receiving a request to merge documents containing information about a document authoring application (Column 4, lines 25-26; 'the referencing is thereby particularly controlled via data that are input via a user interface') that created the second document; and

wherein the converting of the second document from the original format to the merge format to create the second merge document includes:

generating, based on the information about the document authoring application, a set of conversion instructions (The program code or device which enables the PCL converter 18 in Figure 2) to convert the second document into said second merge document;

passing the set of conversion instructions to the document authoring application (Column 9, lines 59-62; "Enhanced Print Environment (EPE) Print Processor" 49a does not forward the EMF data directly to the port monitor 51 but calls the converter unit 58, wherein the EMF data stream is converted into a PCL print data stream 60'); and

the document authoring application generating the second merge document based on said set of conversion instructions (Column 9, lines 65-67, 'The conversion is thereby controlled by the parameters that were previously input via the input module 59').

Regarding Claim 24: (previously presented)

Claim 10 teaches the method. Claim 24 is obvious in view of Schwier and Warmus because a computer-readable medium containing computer executed instructions is achieved using the method steps of Claim 10.

Regarding Claim 11: (original)

Schwier et al. further discloses the method of claim 1, wherein the composite merge document is in the merge format (Column 3, lines 56-67).

Regarding Claim 25: (previously presented)

Claim 11 teaches the method. Claim 25 is obvious in view of Schwier and Warmus because a computer-readable medium containing computer executed instructions is achieved using the method steps of Claim 11.

Regarding Claim 12: (original)

Schwier et al. further discloses the method of claim 1, wherein the composite merge document is a **template** for creating other documents (FIG. 5 shows a **master** document 25).

Regarding Claim 26: (previously presented)

Claim 12 teaches the method. Claim 26 is obvious in view of Schwier and Warmus because a computer-readable medium containing computer executed instructions is achieved using the method steps of Claim 12.

Regarding Claim 13: (previously presented)

Schwier et al. further discloses the method of claim 1, further comprising;

Receiving at the merge utility, a request to merge wherein the steps of converting the second document and merging the first merge document and the second merge document are both performed in response to the merge utility receiving the request to merge documents. documents (The program code which is embodied on a computer readable media and operable to requests the merge utility described in Column 6, lines 8-18 to merge documents and in Claim 20.)

Regarding Claim 27: (previously presented)

Claim 13 teaches the method. Claim 27 is obvious in view of Schwier and Warmus because a computer-readable medium containing computer executed instructions is achieved using the method steps of Claim 13.

Regarding Claim 14: (previously presented)

Schwier et al. further discloses the method of claim 1 further comprising:
receiving at the merge utility, a request to merge documents (Column 7, lines 20-25; in order to merge the system must receive a merge command);
generating the first merge document in said merge format by converting a first original document from an original format to the merge format (See PCL converter 18 in Figure 2);

wherein the merge format is Standard Printing and Imaging Format (SPIF) (Column 3, lines 61-64; 'the conversion of the data stream into a print language such as PCL or postscript');

wherein the first document is a background template document and the second document is an overlay document (Column 8, lines 64-67; 'The placement type as an **overlay** (complete superimposition) or a **watermark** (macro information only in the background) within the document **can be selected** with the selection field 44').

wherein the background template document is originally created by a first document authoring application (e.g., WinWord Application 10 in Figure 2); and

wherein the second document authoring application that is different from said first document authoring application (e.g., Excel document);

wherein the background template document is created in a second original format and converted from the second original format to the merge format (e.g., Master Document described in Column 9, lines 32-35).

Regarding Claim 28: (previously presented)

Claim 14 teaches the method. Claim 28 is obvious in view of Schwier and Warmus because a computer-readable medium containing computer executed instructions is achieved using the method steps of Claim 14.

Regarding Claim 29: (previously presented)

Schwier discloses the method of Claim 1, wherein the first merge document is a version of a first document that has been converted from an original format to the merge format (e.g., Word application converted to PCL as shown in Figure 9).

Regarding Claim 30: (New)

Warmus further discloses the method of Claim 1, wherein the merge utility performs the step of converting a second document from an original format to the merge format to create a second merge document by causing the first document authoring application to convert the second document to to said second merge document (The files 134, 136 are converted into files 137, 138 in a PDL format, for example, PostScript.RTM.. An optional imposition process may convert the PDL files into improved final variable page files 139; Column 8, lines 33-36).

Regarding Claim 31: (New)

Claim 29 teaches the method. Claim 31 is obvious in view of Schwier and Warmus because a computer-readable medium containing computer executed instructions is achieved using the method steps of Claim 29.

Regarding Claim 32: (New)

Claim 30 teaches the method. Claim 32 is obvious in view of Schwier and Warmus because a computer-readable medium containing computer executed instructions is achieved using the method steps of Claim 30.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sciatto (US 6,330,073) discloses A system and method for generating a plurality of customized documents having at least one portion of common information and at least one portion of variable information.

Examiner Notes

6. The Examiner cites particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully considers the references in its entirety as potentially teaching all or part of the claimed invention, as

well as the context of the passage as taught by the prior art or as disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil R. McLean whose telephone number is (571)270-1679. The examiner can normally be reached on Monday through Friday 7:30AM-4:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on 571.272.7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Neil R. McLean/
Examiner, Art Unit 2625

Application/Control Number: 10/733,102
Art Unit: 2625

Page 17

/David K Moore/

Supervisory Patent Examiner, Art Unit 2625